

**Application No.: 09/545,658**  
**Filing Date: April 10, 2000**

## **REMARKS**

The July 22, 2009 Office Action was based on pending Claims 33–40, 42–45, 52–54, 56–62, 65 and 67–70. By this Response, Applicant is amending Claims 33 and 59 without prejudice or disclaimer. Claims 34–40, 42–45, 52–54, 56–58, 60–62, 65 and 67–70 remain as previously presented.

Thus, after entry of the foregoing amendments, Claims 33–40, 42–45, 52–54, 56–62, 65 and 67–70 are pending and presented for further consideration. In view of the foregoing amendments and the remarks set forth below, Applicant respectfully submits that Claims 33–40, 42–45, 52–54, 56–62, 65 and 67–70 are in condition for allowance.

## **PRIOR PROSECUTION HISTORY**

Applicant notes that the present application has received numerous Office Actions (i.e., 6 Non-final Office Actions and 5 Final Office Actions). Moreover, Applicant's representatives have arranged three in-person interviews with the Examiner to discuss amendments in an effort to put the claims in condition for allowance. During at least one of the interviews, the Examiner indicated that he would contact Applicant's representatives prior to issuing a subsequent Office Action in an effort to reach an agreement on the claims. However, such contact was never initiated by the Examiner prior to the subsequent Office Actions.

## **CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)**

The Office Action rejects the pending claims of the present application under 35 U.S.C. § 103(a). In particular, based on the comments in the Office Action, Claims 33–36, 38, 53, 62, 67 and 69 appear to be rejected as being unpatentable over U.S. Patent No. 5,865,680 to Briggs ("Briggs") in view of U.S. Patent No. 6,426,741 to Goldsmith ("Goldsmith"). Claims 37, 39, 40, 42–45, 52, 54, 56–61, 65, 68 and 70 appear to be rejected as being unpatentable over Briggs and Goldsmith in further view of U.S. Patent No. 5,114,155 to Tillery et al. ("Tillery") and U.S. Patent No. 6,371,375 to Ackley et al. ("Ackley").

Applicant respectfully traverses these rejections, the characterization of the pending claims and the cited references, and each and every implicit and/or explicit reliance on Official Notice. Moreover, in view of the foregoing amendments and for at least the reasons set forth below, Applicant respectfully requests reconsideration of the aforementioned claims.

**Independent Claim 33**

Focusing on amended independent Claim 33, in one embodiment of Applicant's invention an interactive gaming system is disclosed for entertaining one or more play participants. The system includes a play structure and one or more play modules disposed within the play structure. Each of the play modules comprises multiple play elements with interactive challenge(s) to be played by play participant(s) as part of an interactive game.

The system also includes a toy wand operable by at least one play participant by motioning the wand in a predetermined manner to transmit a first signal to wirelessly actuate the play element(s). The toy wand further includes a memory configured to (i) store identification information for uniquely identifying the play participant and (ii) store participant progress information, received by the toy wand, in the interactive game. The toy wand is further configured to wirelessly transmit the identification information or the progress information to the play element(s) during participation by the play participant in the interactive challenge(s), and the play element is configured to adjust the interactive challenge(s) using the progress information.

As discussed in more detail below, neither Briggs, nor Goldsmith, nor a combination thereof, teaches or suggests the interactive gaming system of amended independent Claim 33. For instance, the Office Action acknowledges that neither Briggs nor Goldsmith teaches or suggests a substantial portion of the claim, including:

... the toy wand . . . comprising a memory configured to (i) store identification information for uniquely identifying said at least one play participant of said one or more play participants and (ii) store progress information received by the toy wand indicative of a progress of the at least one play participant in the interactive game,

the toy wand being further configured to wirelessly transmit at least one of said identification information and said progress information to at least one of said multiple play elements during participation by said at least one play participant in said one or more interactive challenges, and

wherein the at least one of said multiple play elements is further configured to adjust said one or more interactive challenges using at least said progress information.

### **Briggs**

Briggs is directed to “a kinetic interactive play structure for entertaining and educating children and adults” (Abstract). For instance, the Briggs play structure can include a number of kinetic play elements (e.g., wheels, pulleys, gears, windmills) that are activated to transfer kinetic energy from one to another in a chain of triggering events to complete a desired result or effect (see, e.g., col. 2, lines 40–55 and 63–66).

The Office Action cites Briggs, in particular, for teaching the following elements recited in independent Claim 33:

- 1) A play structure; and
- 2) One or more play modules disposed within said play structure and configured to receive or support one or more play participants playing therein or thereon, each of said one or more play modules comprising multiple play elements comprising one or more interactive challenges configured to be played by said one or more play participants as part of an interactive game.

### **Goldsmith**

Goldsmith discloses an input device (10) for transmitting one-way signals for controlling a computer presentation of video signals through the use of a lamp (14) (see, e.g., column 1, lines 38–40). Goldsmith also discloses that “[o]ther forms of radiation could be used to convey information from the wand to the computer, including infrared, sound, or radio frequency waves” (col. 3, lines 31–34) (emphasis added).

The Office Action relies upon Goldsmith for teaching the following element of independent Claim 33:

[A] toy wand operable by at least one of said one or more play participants by waving, shaking, stroking and/or tapping said toy wand in a predetermined manner to transmit a first signal to wirelessly actuate [a device].

**The Combination of Briggs and Goldsmith Does Not Teach Every Limitation of the Claimed Interactive Gaming System**

As outlined above, the combination of Briggs and Goldsmith does not teach every feature of independent Claim 33. Rather, the Office Action takes a piecemeal approach in rejecting the claims and states in a conclusory manner that each of the multiple non-taught limitations would have been obvious to one of ordinary skill in the art. Certain of these non-taught limitations are discussed in more detail below:

**1. A wand comprising a memory storing identification information and progress information received by the toy wand**

With respect to the claim limitation “[a] toy wand . . . comprising a memory configured to (i) store identification information for uniquely identifying said at least one play participant of said one or more play participants and (ii) store progress information received by the toy wand indicative of a progress of the at least one play participant in the interactive game,” the Office Action states the following on pages 4 and 5 as its basis for rejection:

Goldsmith’s wand only consists of a transmitter and the controlled device only consists of a receiver. However, connecting a transceiver (i.e. a transmitter and receiver) to an electronic device so that the device will be able to transmit and receive signals is knowledge generally available to one having ordinary skill in the art (see Ackley col 6:35-55). Furthermore, using a memory to store player/game information and a transceiver inside a player control device in an interactive play set is also well known in the art (for example, see the player badge and nodes in Gabai et al US Patent 6352478). Goldsmith’s invention will not cease to work if a receiver is substituted for a transceiver and a transmitter is substituted for a transceiver. A predictable result of receiving and transmitting signals will be achieved. . . . Goldsmith teaches that the wand is capable of storing program data and event driven information into a memory (col 2:47-51). To store player identification data into this memory . . . would have been obvious to one having ordinary skill in the art.

Applicant respectfully traverses this reasoning and submits that the Examiner’s conclusion of obviousness is improper. For instance, Goldsmith is directed to an input device that emits light signals detected by a camera in order to control a computer presentation. There is no teaching, suggestion, or reasoning for using the Goldsmith input device, which is a one-way communication device, for receiving and storing

progress information or player identification information in an interactive game or for using the Goldsmith input device with a transceiver.

The Office Action specifically cites the player badge of U.S. Patent No. 6,352,478 to Gabai et al. ("Gabai") as using a memory to store player and game information and a transceiver inside a player control device. However, it appears that this player badge only stores "visitor-identification data" (see, col. 51, lines 1–14). Since Gabai is fairly lengthy, Applicant respectfully requests the Examiner to point to the specific portion of Gabai that the Examiner believes teaches a player badge storing progress information of a player in an interactive game.

Even if the Goldsmith wand could be modified to include such a memory, Goldsmith still does not teach or suggest wirelessly receiving data for storage on the wand, as acknowledged by the Office Action. To this end, the Office Action states that the transmitted of the Goldsmith wand could be replaced with a transceiver. Rather than providing concrete suggestions or motivations that a skilled artisan would have to modify the Goldsmith input device to include the transceiver, the Office Action merely comments on purported functionality of the proposed modification. That is, the Office Action states on page 5 that "Goldsmith's invention will not cease to work if a . . . transmitter is substituted for a transceiver" and that a "predictable result of receiving and transmitting signals will be achieved." However, there appears to be no reason stated in the Office Action, except from the claim itself, why a skilled artisan having the Goldsmith device would be prompted to modify the Goldsmith input device in the manner suggested by the Examiner.

Applicant further notes that the proposed modification of the Goldsmith "wand" device would also require a modification of Goldsmith's digital camera (16), which captures the light signals of the wand (10), in order for the wand to also receive communication. Such a proposed modification is far from the teachings or intended purpose of Goldsmith.

**2. A wand configured to transmit identification information and/or progress information to a play element**

With respect to the claim limitation "the toy wand being further configured to wirelessly transmit at least one of said identification information and said progress information to at least one of said multiple play elements during participation by said at least one play participant in said one or more interactive challenges," the Office Action states on page 5:

Goldsmith teaches that the wand is capable of storing program data and event driven information into a memory (col 2:47-51). To store player identification data into this memory and to transfer this information to a device (i.e. in this case, each play elements) that is activated by the wand user would have been obvious to one having ordinary skill in the art. This way, Briggs system can incorporate means to account for each mission completed by the participants.

Thus, the Office Action merely uses the teaching of Applicant's claim as a blueprint and support for modifying the Goldsmith wand and combining the modified wand with the Briggs kinetic play structure. It is not sufficient in a claim rejection to apply hindsight to piece together prior art to show the teaching of Applicant's invention. When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985); see also M.P.E.P. § 2145(X)(A).

**3. A play element that adjusts one or more interactive challenges using at least the progress information**

With respect to the claim limitation "the at least one of said multiple play elements [being] further configured to adjust said one or more interactive challenges using at least said progress information," the Office Action states on pages 5 and 6 (with citations removed):

Briggs also teaches the idea of the game challenges being completed in sequential order before another module can be played or completed. It would have been obvious to store the player's progress in the wand's memory storage device so as to electronically facilitate the sequential completion of challenges as taught by Briggs. Thus, it would have been obvious to one having ordinary skill in the art to have the wand configured

to adjust said one or more interactive challenges using at least said progress information.

Thus, it appears that the Office Action is asserting that the “modified” Goldsmith wand adjusts the interactive challenge(s). However, Applicant notes that the claim recites that the play element adjusts the interactive challenge(s) using the transmitted progress information. The “play elements” identified by the Office Action comprise the play elements of Briggs structure, which are kinetic devices (e.g., wheels, pulleys, gears, windmills) and are not capable of adjusting interactive challenges based on stored progress information of a play participant.

**The Combination of Briggs and Goldsmith Is Not Proper**

Applicant respectfully submits that it would not have been obvious to a skilled artisan at the time of Applicant’s invention to combine Briggs and Goldsmith, as modified above, to teach the interactive gaming system of independent Claim 33. For instance, there appears to be no suggestion or motivation to use the input device of Goldsmith to wirelessly actuate play elements in a kinetic play structure (Briggs).

The Office Action’s reasoning for combining Briggs and Goldsmith appears to be that it would have been obvious “to have implemented a wizardry/fairy type game theme with Briggs play structure where one of the play elements comprises of Goldsmith’s wand” (page 4). The Office Action emphasizes that this combination could be found in the “references themselves or in the knowledge generally available to one of ordinary skill in the art” (page 9). For example, the Office Action states that such motivation to combine Briggs and Goldsmith could be found in column 3, lines 3–5, of Briggs “where it states that other game themes could be implemented” and would “further add to the entertaining factor of Briggs invention” (page 4).

Applicant respectfully submits that the Office Action’s reasoning for combining Briggs and Goldsmith does not meet the legal requirement for supporting a legal conclusion of obviousness. For instance, there is no wizardry/fairy type theme discussed in independent Claim 33, and none of the cited references contemplates such a theme. Moreover, Applicant is unable to see how such reasoning is derived from the knowledge generally available to a skilled artisan.

Rather, Applicant submits that such a combination does not satisfy the standards consistently articulated by the courts for establishing a *prima facie* case of obviousness. For example, the Supreme Court has explained that “a patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 U.S.P.Q.2d 1385, 1396 (2007). “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006) (emphasis added)). Moreover, when references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. See *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985); see also M.P.E.P. § 2145(X)(A).

### **Summary**

Because Briggs and Goldsmith cannot be properly combined and, even if they are combined, do not disclose, teach or suggest each and every element of amended Claim 33, Applicant asserts that Claim 33 is patentably distinguished over the cited references, and Applicant respectfully requests allowance of Claim 33.

### **Independent Claims 42, 52 and 59**

Each of independent Claims 42, 52 and 59 is believed to be patentably distinguished over the cited references for reasons similar to those set forth above with respect to the patentability of independent Claim 33 and for the different aspects recited therein. That is, neither Briggs, nor Goldsmith, nor Tillery, nor Ackley, nor any combination thereof, teaches or suggests every element of these independent claims.

For instance, none of the cited references teaches or suggests a motion-operated toy device having a memory that stores identification information and game progress information, which can be wirelessly communicated from the toy device to play element(s) during the performance of an interactive game. Moreover, none of the cited references teaches or suggests one or more play elements configured to adjust

interactive game(s) or challenge(s) using at least progress information wirelessly obtained from the toy device.

Ackley discloses a system for storing and retrieving data using a device capable of reading both machine-readable symbols and memory devices (see Abstract). For instance, with reference to Figure 5, Ackley discloses a reader (60) having a transceiver (102) configured to read a container having both a barcode symbol (14) and a radio frequency (RF) tag (10) (see col. 5, line 39, through col. 6, line 55).

Tillery is directed to a card that records player statistics for a dart game.

Furthermore, Applicant submits that there appears to be no suggestion or motivation to combine the identification card of Tillery with the kinetic play structure of Briggs, the computer input device of Goldsmith and the memory reading device of Ackley. For example, the Office Action states that combining Briggs and Goldsmith with Tillery would "facilitate the saving/pausing of a game especially in the common gaming case where the player leaves the game for a bathroom break." However, this stated motivation appears to have no relation to the claimed invention, the cited references or the knowledge of a skilled artisan. Again, mere conclusory statements or personal opinions/knowledge, without an articulated reasoning with some rational underpinning, cannot be used to support a legal conclusion of obviousness.

### **Dependent Claims**

Claims 34–40, 67 and 68 depend from independent Claim 33 and are believed to be patentably distinguished over the cited references for the reasons set forth above with respect to Claim 33 and for the additional features recited therein.

Claims 43–45 depend from independent Claim 42 and are believed to be patentably distinguished over the cited references for the reasons set forth above with respect to Claim 42 and for the additional features recited therein.

Claims 53, 54 and 56–58 depend from independent Claim 52 and are believed to be patentably distinguished over the cited references for the reasons set forth above with respect to Claim 52 and for the additional features recited therein.

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Claims 60–62, 65, 69 and 70 depend from independent Claim 59 and are believed to be patentably distinguished over the cited references for the reasons set forth above with respect to Claim 59 and for the additional features recited therein.

**Applicant's Traversal of Official Notice with Respect to Claims 68 and 70**

With respect to dependent Claims 68 and 70, the Examiner appears to take Official Notice in combination with four other references that “to add a vibrating type notification signal to the already taught light and sound notification signal is a matter of design choice well within the skill set of an ordinary skilled artisan” (page 8).

Applicant respectfully again traverses the Examiner's assertion of Official Notice. In particular, as discussed above, none of the cited references teaches a toy wand that receives wireless communication via a transceiver. For instance, the wand-like device of Goldsmith only transmits information (e.g., via a light bulb) to a camera. Thus, none of the cited references teaches or suggests a toy wand that produces vibration or sound upon receiving wireless communication because no cited reference discloses a toy wand that receives communication.

In view of the foregoing, Applicant respectfully disagrees that such elements recited in Claims 68 and 70 can be considered a “design choice” since the cited art would not be capable of performing the claimed features. Thus, Applicant respectfully repeats its request for documentary evidence supporting the Examiner's assertion that it would be a matter of design choice for the Goldsmith input device to produce “at least one of vibration and sound . . . in response to receiving said wireless communications”

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

Submitted concurrently herewith is a Supplemental Information Disclosure Statement citing eleven (11) references. Applicant respectfully requests the Examiner to consider the pending claims in connection with these references in order to make them of record.

**NO DISCLAIMERS OR DISAVOWALS**

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding

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in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

### **CONCLUSION**

In view of the foregoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain, the Examiner is cordially invited to contact the undersigned such that the issues may be promptly resolved.

Moreover, by the foregoing amendments and remarks no admission is made that any of the above-cited references are properly combinable. Rather, Applicant submits that even if the references are combined, the references still do not teach or suggest the claimed invention.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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